

REMARKS

Applicants have carefully reviewed the above identified application in light of the Office Action dated March 15, 2004. Claims 4-8, 11-14 and 16 are now presented for examination. Claims 1, 2, 9, 10 and 15 have been cancelled without prejudice or disclaimer of subject matter.

Claims 5, 11 and 12 are the only independent claims.

Claims 1, 2, 9, 10, 15 and 16 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 3,774,618 (Avery). Claims 1, 2, 9, 10, 15 and 16 were also rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 5,476,494 (Edell). Claims 1, 2 and 14-16 were rejected under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure. Claims 7, 11, 12 and 16 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

First, cancellation of Claims 1, 2, 9, 10, and 15 renders the rejections of those claims moot.

On May 19, 2004 a telephonic interview was conducted between Examiner Cohen and Thomas Onka, Attorney for Applicants. During that interview Mr. Onka noted that no art rejection was presented in the March 15, 2004 Office Action, indicating that Claims 4-8 and 11-14 would be allowable if rewritten so as not to depend from a rejected claim, and with no change in scope. In the interests of furthering prosecution, Applicants herewith have so rewritten these claims with only minor changes to the claim language. In particular:

Claim 5 has been amended to incorporate the features of Claims 1 and 2;

Claim 11 has been amended to incorporate the features of Claims 9 and 2; and,

Claim 12 has been amended to incorporate the features of Claims 10 and 2.

As it is not obvious from the “marked-up” copy of the claims appearing above, Applicants wish to draw the Examiner’s attention to the fact that the phrase “minimizing means” which appeared in Claim 1 has been changed to “reducing means” (in the new version of claim 5). In addition the term “optimize” of Claim 10 has been changed to “improve” in the new version of Claim 12. These new terms better reflect the nature of the invention in which an improved condition, rather than an absolute one (i.e., “minimal” and “optimal”), is attained.

The claims have been carefully reviewed and amended as deemed necessary to ensure that they conform fully to the requirements of Section 112, second paragraph, with special attention to the points raised in the Office Action. It is believed that the rejection under Section 112, second paragraph, has been obviated, and its withdrawal is therefore respectfully requested.

As to the rejection under 35 U.S.C. § 112, first paragraph, applicants submit that the current specification, in light of the acknowledged prior art (e.g., the Stieglitz article referenced at page 1, line 28 of the specification), properly enables the current claims. In the May 19, 2004 Telephonic Interview, Examiner Cohen requested that rather than submitting a Declaration Under 37 C.F.R. §1.132, Applicants identify the sections of the specification that address various features of the claims.

1. “reducing means ... comprising a compacting means for compacting the regions that are movable relative to one another” (lines 8-10 of Claim 5)

Figures 1a, 1b and 1c and the accompanying description in the amended specification at page 3, line 28 discuss examples of this feature.

2. "shape modifying means wherein the desired positions of the microcontact structure can be fixed, interchanged or altered" (Claim 5, lines 11-12); "shape modifying means ... utilized to attain a mechanical anchorage" (Claim 11, lines 6-9); "shape modifying means ... utilized to improve an electrical contact" (Claim 12, lines 6-9).

This feature of the invention is illustrated in Fig. 3 and described in the amended specification, inter alia, at page 6, line 9. Fig. 4 illustrates an embodiment of this invention (which is described at page 6, line 29 through page 10 7 of the amended specification) in which infrared and ultraviolet radiation are examples of the shape modifying means. Use of heat/cold is recited in the specification at page 5, lines 16-34 in which a surgical tool or device is employed as the heat/cold source. Accordingly, these examples also support the language of 15 the last two lines of each of Claims 11 and 12 wherein "the shape modifying means is selected from ... a surgical device means and a transmitting means".

3. "shape modifying means wherein the desired positions ... can be fixed, interchanged or altered by external action before implantation, during a surgical intervention or by external signals without surgical intervention" (Claim 5, lines 20 11-13; Claim 11, lines 5-8; Claim 12, lines 5-8)

Fig. 4 illustrates an embodiment of this invention (which is described at page 6, line 29 through page 7 of the amended specification) in which infrared

and ultraviolet radiation are examples of the shape modifying means. Use of heat/cold is recited in the specification at page 5, lines 16-34 in which a surgical tool or device is employed as the heat/cold source. Accordingly, these examples support the recited claimed feature in which the desired positions of the 5 microcontact structure may be changed and this change may be reversed by external action. Further, this can occur before the device is implanted or during surgery. Moreover, external signals can be applied (e.g. infrared signals) to effect a change of an implanted microcontact structure without surgical intervention.

4. “locking means” (Claim 6, line 3)

10 This feature is illustrated in Fig. 1d and the accompanying text of the amended specification commencing at page 4, line 35.

5. “releasing forces at said at least one junction” (Claims 7 and 8)

15 This feature is illustrated by Figs. 1c and 1d . Various releasing forces are described in the specification, inter alia, in the paragraph commencing at page 4, line 23.

Applicants have attempted above to address the important features of the claim language to clarify their meanings and to point to the descriptions contained in the specification which enable one skilled in the art to make and/or use the invention. As 20 discussed in the May 19, 2004 Telephonic Interview, to the extent any claim features have not been adequately addressed, Applicants respectfully request that the Examiner

contact the undersigned Attorney for the Applicants so that further explanations can be timely submitted.

In light of the above amendments and remarks, Applicants submit that the present invention, as defined by independent claims 5, 11 and 12 are patentable over both Avery 5 and Edell. These claims are also believed patentable over the art of record.

The other claims in this application are each dependent from one of the independent claims. In particular, Claim 4 has been amended to depend from Claim 5 and Claim 16 has been amended to depend from Claim 12. Accordingly, each dependent claim herein is believed patentable over the art of record. Since each dependent claim is 10 also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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